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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,718	12/02/2003	Ching-Chi Lin	3073/73	2208

7590 11/17/2005
Dennison, Schultz & Dougherty
612 Crystal Square 4
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Arlington, VA 22202-3417

EXAMINER

LEVINE, ADAM L

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,718

Applicant(s)

LIN, CHING-CHI

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

It is noted that Table 1 appears to be a Drawing although it is labeled Table 1. It is included with the Drawings in the Application. Applicant may wish to clarify the status of Table 1.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

1. Claims 4 and 5 are objected to because of the following informalities: Both claims refer to "the items," however, since these items have not been previously introduced, it is unclear whether specific items are being referred to, or if these claims intend to introduce these items. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 includes reference to "the planner," "the limits of authority," and "manage the safety." These elements are not described in the specification. One skilled in the art to which this application pertains would not be enabled to make and/or use the invention without understanding the meaning or function of those elements. It is impossible to determine their meaning or function in Claim 3 given the information available in the Specification. This Claim is generally narrative and indefinite. It appears to be a literal translation into English from a foreign document and is replete with idiomatic errors.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 1 recites the limitation "proper provider" in part c. The term "proper" is a relative term which renders the claim indefinite. The term "proper" is not defined by the

claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The elements that contribute to the determination of propriety of the provider should be clarified.

Claim 1 recites the limitation "the receiver's data" in part c. There is insufficient antecedent basis for this limitation in the claim. Claim 1 also recites the limitation "said receiver" in part c. There is insufficient antecedent basis for this limitation in the claim. In addition, Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps connecting the recommending of gifts with the contacting of the provider to send the gift, and the determination of the identity of the receiver. For example, in Claim 1, the receiver could be the consumer, or another party. How is the receiver determined?

Claim 3 recites the limitations "the planner," and "the product catalogs." There is insufficient antecedent basis for these limitations in the claim. The "planner" also is not defined in the specification (see above 112 first paragraph rejection).

Claim 4 recites the limitation "parameter." There is insufficient antecedent basis for this limitation in the claim. "Parameters" are previously introduced, however, because the limitation is introduced in plural form, and then in Claim 4 it is modified in singular form, it is unclear what Applicant intends to cover with the use of the term in Claim 4. Is only one parameter being modified, or are all parameters included? This is exacerbated because the term "mainly" in Claim 4 is a relative term that further renders

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the claim indefinite. The term "mainly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 6 and 7 are generally narrative and indefinite, as are the other claims. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. They are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They also attempt to claim both system and method elements within system claims. It is therefore difficult to determine what Applicant intends to claim within the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hudda (US Pub. No. 2001/0049636).

Hudda teaches all of the limitations of Claims 1-7. For example, Hudda discloses a system and method for making purchase recommendations that includes allowing the purchaser to input preference parameters, searching for gift or other purchase items, and distributing the customer transaction to providers based on the desired attributes of

the provider (see at least Abstract, page 1 paras.0009-0017, page 2 paras.0025-0027,0034-0035). Hudda further discloses:

- inputting parameters to a computer system by a consumer according to his needs: wherein said parameter is mainly the price of said gift, or gender, age, living area, marriage, origin of the incident, hobby, relationship, gift category, gift price and occupation of the receiver, and by said parameters and said preplanned database, said gifts are recommended after the items that meet the input parameters of said consumer are found in said database (see at least Abstract; page 1 para.0004; page 3 para.0044,0057,0058; page 8 para.0128. Please note: The specific nature of the parameters involved, for example, price, gender, age, living area, marriage, origin of the incident, hobby, relationship, gift category, gift price and occupation, are descriptive material and are not functionally involved in the recited steps of the method. Any similarly descriptive parameter or parameters could just as easily be used. Because it has no functional role in the method the specific nature of the parameters is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106.)
- searching for gift items that meet said needs by said computer system according to a preplanned database: recommending gifts to said consumer (see at least page 7 para.0106, page 8 paras.0128-0130); wherein receiver's expected gift is input by himself and after the search in the database, the result is transmitted to

the giver, so that said giver gives the proper gift to said receiver in a most economic way (see at least Fig.5A, page 1 para.0015, page 3 para.0050, page 3 para.0058, page 7 para.0109); wherein said database is built by the planner to collect, classify and connect the product catalogs of each factory owner, or open the limits of authority for willing factory owners to provide optimal products, and manage the safety by said planner (see at least page 2 para.0029, page 4 para.0070, page 8 paras.0119,0124,0126,0127,0130,0131).

- automatically contacting proper provider by said computer system according to the receiver's data to send said gift to said receiver: after said consumer selects said gift (see at least Fig.5A, page 2 para.0041, page 11 Claims 1,20).
- a server terminal: database system, member registration system (see at least Abstract, Figs.1, 5A,9).
- a user terminal: including all products that connect said server on line for sending out condition requests to said server terminal and receiving the signal returned by said server terminal (see at least Abstract, Figs.1,7A-9).
- a financial institution: for receiving the authorized requests of said server terminal and returning the authorized response signal to said server terminal (see at least page 2 para.0041, page 5 para.0075, page 6 para.0103,0105; page 7 para.0117).

- regional gift provider: service station in each region for providing services of deliver, maintenance, investigation for gift preferences in specific regions and product packaging, or allocating each regional gift provider to support each other for fast sending the gifts to the receiver (see at least Figs.5B-6, page 1 para.0014).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art references are all directed toward purchase and/or gift recommendation systems and/or methods that base their recommendations on parameters entered by the consumer according to the consumer's or recipient's desires, including searching preplanned databases, servers, terminals, and providers.

- Talib, US Pub. No. 2001/0044758 (November 2001). Teaches enabling efficient search and retrieval of products from an electronic product catalog using multiple, independent hierarchical category taxonomies of the products in the product catalog data collection.
- Ulenas, US Pub. No. 2002/0026390 (February 2002). Teaches method and apparatus for obtaining consumer product preferences through product selection and evaluation.

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- McConnell, US Pub. No. 20020029168 (March 2002). Teaches online product searching method and apparatus based on type of product, manufacturer and product characteristics.
- Kindo, US Pub. No. 2002/0055885 (May 2002). Teaches online ecommerce system and method using keywords derived from advance evaluation of customer preferences.
- Bailey, US Pub. No. 2002/0062258 (May 2002). Teaches computer implemented procurement of items using parametric searching using item category, attributes, etc..
- Chinnappan, US Pub. No. 2002/0082932 (June 2002). Teaches using search queries to search items across multiple seller databases.
- Tenorio, US Pub. No. 2002/0174022 (November 2002). Teaches pre-qualifying of sellers based on seller attributes and categorizing both products and sellers for searching based on attributes and consumer criteria.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571.272.7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine
Patent Examiner
November 10, 2005


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